

TERMINAL DISCLAIMER INFORMAL CHECKLIST

APPL. S.N.: 10/537,357

DATE: 7/2/2010

EXAMINER: MIRIAM BERDICHEVSKY

ART UNIT: 1795

PARALEGAL: /DOROTHEA LAWRENCE/

MAIL ROOM DATE: 9/28/2009

NUMBER OF TD(s) FILED: ONE

INSTRUCTIONS: The paralegal has reviewed the submitted TD with the results as set forth below.

If you agree, please use the appropriate form paragraphs identified by this informal memo in your next Office action to notify applicant about the TD. If you disagree, please contact a QAS.

THIS CHECKLIST IS AN INFORMAL, INTERNAL CHECKLIST ONLY. IT MUST NOT BE MAILED TO APPLICANT. IT WILL BE SOFT SCANNED AND NOT VIEWABLE TO THE PUBLIC.

- ☐ The TD is PROPER and has been accepted and recorded. (See FP 14.23.)
- ☒ The TD is NOT PROPER and has not been accepted for the reason(s) checked below. (See FP 14.24.)
- ☐ The disclaimer fee under 37 CFR 1.20(d) in the amount of \$ _____ has not been submitted, nor is there any pre authorization in the application to charge to a deposit account. (See FP 14.24 and 14.26.07.)
- ☐ The LIE has not processed fee for TD (the Paralegal should ask LIE to process the fee).
- ☐ The TD does not satisfy 37 CFR 1.32(b) (3) in that the person who signed the TD has not stated either: (a) the extent of his/her ownership interest, or (b) the extent of the business/organization entity's ownership interest on whose behalf the person signed. (See FPs 14.26 and 14.26.01.)
- ☐ The TD lacks the – enforceable only during the period of common ownership – clause needed to overcome a double patenting 37 CFR 1.321(c). (See FP 14.27.01.)
- ☐ The TD lacks 37 CFR 1.321(d) statement for joint research agreement under 35 U.S.C. 103(c) (2) & (3). It doesn't include the waiver and enforceability provisions of 37 CFR 1.321(d). (See FP 14.27.011.)
- ☐ TD is directed to a particular claim(s); this is not acceptable, since the disclaimer must be of a terminal portion of the entire patent to be granted, MPEP 1490. (See FPs 14.26 and 14.26.02.)
- ☒ The person who signed the terminal disclaimer:
- ☐ failed to state his/her capacity to sign for the business/organization entity. (See FP 14.28.)
- ☐ is not recognized as an officer of the assignee. (See FP 14.29.)
- ☐ does not have power of attorney, and thus, is not of record. (See FP 14.29.01.)

(Note: PoA can be given to a customer number, wherein all practitioners listed under the customer number have PoA. If PoA is established by a list of practitioners, the list may not comprise more than 10 practitioners. A representative of the assignee, who is not of record, cannot sign the TD unless it is established that the representative is a party authorized to act on behalf of the assignee.)

- ☐ The TD is not supported by evidence of chain of title to the assignee signing the TD due to a failure to submit either: (a) documentary evidence of a chain of title from the original inventor(s) to the assignee and a statement affirming that the documentary evidence was, or concurrently is being, submitted for recordation; or (b) the reel and frame number(s) where such documentary evidence is recorded in the Office. 37 CFR 3.73(b). (See FPs 14.30 and 14.34)

NOTE: This documentary evidence or the specifying of the reel and frame number may be found in the TD or in a separate paper submitted by applicant.)

- ☐ The TD is not supported by adequate evidence of chain of title to the assignee signing the TD, because the person who signed the submission under 37 CFR 3.73(b):
- ☐ has failed to state his/her capacity to sign for the business entity. (See FPs 14.30.02 and 14.16.02
 - ☐ is not recognized as an officer of the assignee. (See FP 14.30.02 and 14.16.03)

(NOTE: On the submission under 37 CFR 3.73(b), the signature of an attorney or agent registered to practice before the Office is not sufficient, unless the attorney or agent is authorized to act on behalf of the assignee.)

- ☐ The TD is not signed (See FPs 14.26 and 14.26.03)
- ☐ The serial number of the application (or the number of the patent) which forms the basis for the double patenting is not identified (i.e., missing or incorrect) in the TD. (See FP 14.32)
- ☐ The serial number of the application being examined (or the number of the patent under reexam or reissue) is not identified or incorrect. (See FPs 14.26 and 14.26.04 or 14.26.05)
- ☐ The TD is not signed by all owners. See FPs 14.26 and 14.26.06.
- ☐ The period disclaimed is incorrect or not specified. (See FPs 14.24, 14.27.02 or 14.27.03)

☒ Other 1.) 37 CFR 1.321(c)(3) requires that a TD "Include a provision that any patent granted on that application or any patent subject to the reexamination proceeding shall be enforceable only for and during such period that said patent is commonly owned with the application or patent which formed the basis for the judicially created double patenting." [Emphasis added]

The words "legal title" do not include common ownership as to equitable title.

- 2.) The TD is defective, as it is over reaching. He excludes the TD from extensions under 35 U.S.C. 154.